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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/871,539 | 05/31/2001 | Akihiro Tada | 70181 | 8903 |

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| EXAMINER | |
|---|---|
| DOTE, JANIS L | |
| ART UNIT | PAPER NUMBER |
| 1756 | 6 |

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/871,539 | Applicant(s) TADA et al. |
|---|---|---|
| | Examiner J. DOTE | Group Art Unit 1756 |

*—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

☒ Responsive to communication(s) filed on 8/8/01.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

☒ Claim(s) 1-25 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claim(s) 1-25 are subject to restriction or election requirement

**Application Papers**

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

**Attachment(s)**

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

**Office Action Summary**

1. The examiner acknowledges the amendments to claims 5, 11, 16, and 21 filed in Paper No. 4 on May 31, 2001. Claims 1-25 are pending.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 and 22-25, drawn to monoazo metal complex compound-containing compositions, toners, and colored thermoplastic resin compositions, classified in class 534, subclass 649+, class 430, subclass 108.23, and class 524, subclass 159+.

II. Claims 7-21, drawn to methods of making a monoazo metal complex compound-containing composition, classified in class 534, subclass 578+.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process,

such as a process comprising the steps of (1) making the monoazo compound by reacting components in a non-alcoholic solvent, an aprotic polar solvent such as N,N-dimethylformamide or N,N-dimethylacetamide, (2) washing the product in water and pressure filtering the washed product, (3) recrystallizing the monoazo compound by dissolving the compound in the aprotic polar solvent and dispersing the solution in water, (4) pressure filtering the solution to obtain the recrystallized product, (5) washing the recrystallized product and pressure filtering the washed product; and (6) repeating the washing and filtering steps to remove the impurities until the monoazo compound has the required property.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and as shown by their different classification, restriction for examination purposes as indicated is proper.

4. If applicants elect the invention of either Groups I and II, the claims in those groups are further subjected to an election of species.

For Group I, claims 23 and 25 are generic to a plurality of disclosed patentably distinct species that comprise distinct compositions. The compositions are directed to the following

distinct species, each of which is classified in a different class or subclass:

Ia. Toner - 430/108.23.

Ib. Thermoplastic composition - class 524, subclass 159+.

If applicant elects either species Ia or Ib, claims 1-6, 22, and 24 will be examined with the elected species. There is a further species election requirement, infra.

For Group II, claims 7-21 are generic to a plurality of disclosed patentably distinct species that comprise distinct process steps. The processes are directed to the following distinct species, each of which is classified in a different class or subclass:

IIa. Claims 7-11, the method comprising the step of removing impurities from a monoazo metal compound with an alcohol organic solvent - class 534, subclass 887.

IIb. Claims 12-21, methods comprising the step of synthesizing the monoazo metal compound in an alcohol solvent - class 534, subclass 578+.

There is a further species election requirement, infra.

Applicants are required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or

identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

If applicants elect any of the inventions Ia, Ib, or IIa, applicants are further required to name an ultimate species of invention, wherein the monoazo metal compound is identified as a unique chemical compound, wherein the metal atom and the monoazo compound are identified as unique chemical moieties. For example, the monoazo metal compound disclosed in example 1 of the instant specification.

If applicants elect invention IIb, applicants are further required to elect an ultimate species of the invention, wherein (1) the monoazo metal compound is identified as a unique chemical compound, wherein the metal atom and the monoazo compound are identified as unique chemical moieties, and (2) the synthesis step requiring the presence of an alcohol solvent is identified as a unique reaction step. For example, diazotization coupling reaction using 4-chloro-2-aminophenol and 2-naphthol dispersed in an alcoholic organic solvent.

Applicants should identify all claims that read on the ultimate elected species of invention comprising the uniquely identified monoazo metal compound.

5. Due to the complexity of the restriction requirements and the further requirement of the identification of the ultimate species of invention, applicants' representative was not contacted to request an oral election to the above restriction requirement.

3. Applicants are advised that a complete reply to this requirement must include an election of invention, an election of species, and the identification of the ultimate species of invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (703) 308-3625. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311 (Rightfax) for after final faxes, and (703) 872-9310 for other official faxes.

Any inquiry of papers not received regarding this communication or earlier communications, or of a general nature or relating to the status of this application or proceeding should be directed should be directed to the Customer Service Center of Technology Center 1700 whose telephone number is (703) 306-5665.

Janis L. Dote

JANIS L. DOTE
PRIMARY EXAMINER
GROUP ~~1500~~ 1700

JLD
September 7, 2002